

# REMARKS

This is a request for reconsideration containing argumentation to overcome the rejections based on disclosures in prior art references in the final Office Action dated July 31, 2007. It is filed in accordance with 37 CFR 1.116.

## I. ANTICIPATION REJECTION BASED ON EP '633

Claims 24, 27, and 29 were rejected under 35 U.S.C. 102 (b) as anticipated by Guenin (EP 0970633 -- designated EP '633 or Guenin herein below). Furthermore attention is called to the machine translation of EP '633 from the French language to the English language, which is available from the European Patent Office Internet website (esp@cenet).

Guenin does disclose a hair dryer that can simultaneously produce a hot air stream and a cold air stream, which emerge side-by-side from an air nozzle attachment 23, as shown in the top view of fig. 2 of EP '633. Furthermore EP '633 teaches that the air nozzle attachment 23 is attached by pushing it over the blow opening on the body of the hair dryer, but that it can be removed again manually for replacement when necessary [0049]. In a preferred embodiment EP '633 teaches that "clips" or protrusions 31 on the interior surface of the air nozzle attachment 23 engage in an annular groove 32 in the exterior wall of the body of the hair dryer near the blower opening (claim 9) so that the air nozzle attachment can be freely rotated but fixed axially for the convenience of the user [0049].

However applicants' claim 24 claims an air nozzle attachment 8 that is

patentably distinguishable from the air nozzle attachment 23 of the hair dryer disclosed in EP '633 by at least one significant structural limitation that is recited in claim 24. This structural difference is a consequence of the structural differences between the hair dryer shown in figs. 1, 2, 3a, and 3b of Guenin and the hair dryer shown in fig. 1 of the above-identified U.S. Patent Application.

On page 3, lines 7 to 9, the final Office Action (in the reasons for the anticipation rejection) one finds the following quoted statement that the air nozzle attachment of EP '633:

“on an end connectable with the blower opening (at 23), is provided with a **central** conduit entrance (not numbered, see Fig. 1, at 23) and a **coaxial** conduit entrance (not numbered, see Fig. 1, at 23) **coaxial** to the central conduit entrance”.

Although the applicants' claimed hair dryer attachment 8 does exhibit this structural feature, which is claimed in claim 24, it is not correct that Guenin discloses any embodiments of their hair dryer with this feature (because of the use of the term “coaxial” in the limitation in claim 24). Furthermore this difference is not an insignificant difference because it affects the ability of the user of the hair dryer to protect the customer or themselves from burns from the heated nozzle attachment, as will be explained in more detail herein below.

The analysis in the Office Action neglects that fact that the nozzle and hair dryer are three-dimensional objects. Figs. 3b and 2 of EP '633 clearly show that the entrance to the air nozzle attachment 23 of EP '633 for the hot air stream (at 26) is off center from the entrance to the air nozzle attachment for the cold air stream (at 22) (see fig. 3b especially). Thus fig. 2 and especially fig. 3b clearly show that the conduit entrance for the cold air to the nozzle attachment of EP

'633 is not coaxial with the conduit entrance for the hot air. "Coaxial" with respect to the circular conduit entrances means that they have coincident axes or are arranged on coincident axes passing through their centers. However fig. 3b of EP '633 clearly shows that the two circular entrances for the hot and cold air are not concentric but are offset from each other so that they do not have a common center or coincident axes that pass through their centers. Also the circular entrance for the hot air stream is **not** a **central** entrance according to EP '633, but is displaced to one side of the nozzle attachment so that hot air directly contacts one side of the air nozzle attachment in the vicinity of the blower opening.

The non-coaxial structure for the air stream entrances of the air nozzle attachment of EP '633 is necessary because the conduit 8 for the hot air stream in the hair dryer of EP '633 is within and not coaxial with the conduit 10 for the cold air stream so that the circular open end of the conduit 8 is rotatable around the open end of part 2 (see fig. 3b) to position the hot air stream as desired by the user of the hair dryer (see claim 6, fig. 2, and paragraphs [0023] and [0024] of EP '633). As a result as explained in paragraphs [0061] and [0062] this structure and the rotatability of the air nozzle attachment 23 permit the hot air stream to be adjusted with the movements of the hair dresser.

There is no disclosure or suggestion of the applicants' claimed subtle structural arrangement of the hot and cold air entrances of the air nozzle attachment as quoted above from the Office Action and as claimed in claim 24. As noted above, this structure provides significant safety advantages over the

structure of the air nozzle attachment shown in figs. 1 and 2 of EP '633. One entire side of the air nozzle attachment 23 of EP '633 remains hot because it is the wall of the hot-air flow through duct 25 as shown in fig. 2 and 3b of EP '633. Thus the hot side of the air nozzle attachment 23 of EP '633 could still burn the individual that is treated during the hairstyling. In contrast in the air nozzle attachment 8 claimed in applicants' claim 24 the hot air flow through the air nozzle attachment 8 is confined to the center of the air nozzle attachment at least in the vicinity of the conduit entrances because the circular inlet opening for the hot air is centered in the entrance to the air nozzle attachment 8 and the outer wall of the hot air nozzle 13 is surrounded by cold air, at least in the vicinity of the conduit entrances. Thus the air nozzle attachment 8 has a cold outer wall around its entire circumference at least until the tip region of the air nozzle attachment is reached in the embodiment shown in the figs 5 and 6 of applicants' specification.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

EP '633 does not disclose or suggest the above-described structural limitation that provides cooler outer nozzle attachment walls around the entire circumference of the nozzle attachment at least in vicinity of the entrance of the nozzle attachment for the air flows. This provides an improved nozzle attachment that is less likely to burn the scalp by accidental contact of the nozzle attachment.

For the foregoing reasons withdrawal of the rejection of claims 24, 27, and 29 under 35 U.S.C. 102 (b) as anticipated by Guenin (EP 0970633) is respectfully requested.

## II. OBVIOUSNESS REJECTION BASED ON EP '633

Claims 25 to 26, 28, and 31 to 33 were rejected as obvious under 35 U.S.C. 103 (a) over Guenin (EP '633).

Guenin (EP '633) does **not** disclose or hint or suggest that the air nozzle attachment:

"on an end connectable with the blower opening (at 23), is provided with a **central** conduit entrance (not numbered, see Fig. 1, at 23) and a **coaxial** conduit entrance (not numbered, see Fig. 1, at 23) **coaxial** to the central conduit entrance",

as stated on page 3 of the final Office Action. The absence of these structural limitations from the disclosure of EP '633 was explained above.

These limitations are subtle structural differences that are not suggested by any other prior art reference and also not suggested in the disclosure of EP '633. However these subtle structural differences help to provide an air nozzle attachment as claimed in claim 24 that has cooler outer wall portions than the air nozzle attachment 23 of EP '633, which provides an improvement in the safety during usage.

Thus the differences between the structure claimed in claim 24 and that disclosed in EP '633 are not inconsequential, but instead are significant and provide an improved safer air nozzle attachment than that disclosed in the EP

reference.

It is well established by many U. S. judicial opinions that to reject a claimed invention under 35 U.S.C. 103 (a) there must be some hint or suggestion in the prior art of the modifications of the disclosure in a prior art reference or references used to reject the claimed invention, which are necessary to arrive at the claimed invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2<sup>nd</sup> 1313 (Fed. Cir. 2000) -- see also M.P.E.P. 2141.

Although a proper application of these principles requires consideration of the prior art in general, it is certainly true that there is no suggestion of the distinguishing limitations in EP '633 itself. Also it is respectfully submitted that no prior art reference is of record in this application, which would suggest the identified distinguishing limitations in claim 24. Furthermore these subtle structural differences for the hot and cold air entrances of the nozzle attachment are the opposite of obvious for one of ordinary skill in the art, who knows the art of designing and using hair dryers.

Thus it is respectfully submitted that EP '633 does **not** establish a case of *prima facie* obviousness of the subject matter of claim 24.

Furthermore the structure of the air nozzle attachment 23 of figs. 1, 2, and 3a and 3b of EP '633 requires that the hair dryer structure itself must be complex and expensive because it requires the mounting of a rotating interior conduit for the hot air stream to provide maximum flexibility in directing the hot air stream in use. In contrast, the conduits for the air flows are not moving parts in applicants' hair dryer because of the structure of the air nozzle attachment 8.

Dependent claims 25 to 26, 28, and 31 to 33 depend on independent nozzle attachment claim 24 and thus share in the limitations of claim 24. Therefore it is respectfully submitted that EP '633 also does not establish a case of *prima facie* obviousness of the subject matter of dependent claims 25 to 26, 28, and 31 to 33.

With respect to claims 32 and 33 applicants, who are experts in the field of hair treatment methods using hair dryers, inform us that they do not know of any hair dryers with dual nozzles for hot and cold air streams that are color-coded. Thus color-coding to signal a hot part is not employed in the hair dryer field and not obvious within the hair dryer field, although it would be obvious in the case of hot and cold water faucets and in the plumbing arts.

Furthermore there is absolutely no disclosure in EP '633, the reference on which the obviousness rejection is based, that the hot and cold nozzles should be color-coded.

Even under the doctrine of "official notice" applicants were entitled to request citation of a prior art reference that shows the claim limitations that were

noted in the Office Action under the doctrine of official notice. It is only fair that an obviousness rejection of an apparatus should be based on prior art references that disclose all the limitations of the apparatus. Otherwise the burden of establishing a *prima facie* case of obviousness has not been overcome. Thus a prior art reference disclosing color-coding of nozzles of a dual stream hair dryer should have been cited if it is available.

Finally the Office Action mentions that the color-coding comprises printed matter on page 6. This is incorrect because the color could be applied by means of paint or could be provided by a pigment that is incorporated in the plastic nozzle material. Furthermore it is doubtful that a nozzle could be "printed" with a color because of its irregular shape. Thus the printed matter exception does not apply here. The color-coding contributes to the overall objective of making the hair dryer safer to use and to avoid burning the customer and thus helps to attain the objects of the claimed invention.

For the additional reasons in the immediately preceding paragraphs it is respectfully submitted that EP '633 does not establish a case of *prima facie* obviousness of the subject matter of claims 32 and 33.

For the foregoing reasons in this section II and also in section I of these REMARKS, withdrawal of the rejection of claims 25 to 26, 28, and 31 to 33 as obvious under 35 U.S.C. 103 (a) over Guenin (EP 0970633) is respectfully requested.

Also it is respectfully submitted that claims 24, 27, and 29 should not be rejected as obvious under 35 U.S.C. 103 (a) over Guenin (EP 0970633).



### III. OBVIOUSNESS REJECTION OF CLAIM 34

Claim 34 was rejected as obvious under 35 U.S.C. 103 (a) over Guenin (EP 0970633), in view of Hubbuch (G 9100860.3 -- referred to as Hubbuch below).

Claim 34 claims a hair dryer with a second nozzle attachment 23 that only produces hot air and a first nozzle attachment 8 that simultaneously produces a stream of cold air and a stream of hot air. The first nozzle attachment 8 in claim 34 includes all the structural limitations of the independent air nozzle attachment claim 24.

There is no suggestion of the distinguishing limitations of claim 34, which reside in the definition of first nozzle attachment 8 in claim 24, in EP '633 itself. Thus EP '633 does not by itself establish a case of *prima facie* obviousness of claim 34.

Hubbuch does not supply any hint or suggestion to modify the air nozzle attachment 23 of EP '633 to obtain the applicants' claimed first nozzle attachment 8. The issue here is air nozzle attachment structures, **not** hair dryer structures, since applicants rely on the structures of air nozzle attachment 8 to distinguish claim 34.

Hubbuch only shows a very simple diagrammatic air nozzle attachment structure comprising two side-by-side conduits with a simple partition between the conduits. The structure for generating two hot air streams, two cold air

streams or a hot and a cold air stream resides in the body of the hair dryer itself. Obviously one could accomplish *similar* results with a single stream air dryer that includes a heating in its body that is powered by an electrical circuit with a variable resistor controlled by knob and with a fan that is similarly controlled by an electrical circuit with a variable resistor control for fan speed or power. These latter features have nothing to do with air nozzle attachment structure. The air nozzle attachment of Hubbuch is not detachable and thus does not teach anything regarding modifications of a detachable air nozzle attachment for a hair dryer.

Hubbuch does not disclose or suggest the modifications of the air nozzle attachment 23 of EP '633 that are necessary to arrive at the first air nozzle attachment 8 as claimed in claim 34.

It is well established that the prior art must disclose or suggest the modifications of the combined features of the cited prior art references that are necessary to arrive at the claimed invention for a valid rejection under 35 U.S.C. 103 (a). For example, the Federal Circuit Court of Appeals has said:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783-84 (Fed. Cir. 1992)

For the foregoing reasons and because of the structural differences between the first air nozzle attachment 8 of claim 34 and that of Guenin, EP '633,

withdrawal of the rejection of claim 34 as obvious under 35 U.S.C. 103 (a) over Guenin (EP 0970633), in view of Hubbuch (G 9100860.3) is respectfully requested.

#### **IV. REQUEST FOR NEW DRAWINGS**

The changes in the drawing figures were approved in the Office Actions dated December 14, 2006 and June 16, 2006. It is the usual practice here to wait until an application is allowed prior to submitting formal drawings that satisfy the formal rules of the USPTO for drawing figures. Applicants will file formal drawings in response to a Notice of Allowance.

#### **V. REQUEST FOR A CLEAN COPY OF THE ABSTRACT AND A SUBSTITUTE SPECIFICATION**

The *request* for a copy of the abstract and a substitute specification on page 5 of the final Office Action has been noted, but it is also noted that the abstract and substitute specification have not been formally *required*.

Like the situation with the drawing figures, applicants are willing to supply clean copies of the specification with the changes and a clean copy of the abstract for clerical purposes when a Notice of Allowance has been received or alternatively after some indication of allowable subject matter in the claims has been received. Note that the attorney for the applicants has provided his

telephone number herein below for discussion regarding this issue.

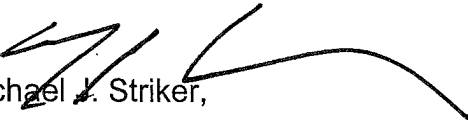
Furthermore the changes in the abstract in the amendment of March 13, 2007 appear on a separate page 6 of the amendment and can be easily scanned because there are not a large number of changes in the abstract so that the requirement for another copy of the abstract is difficult to understand. Note that all changes in the abstract must be made in relation to the immediately prior version, which was the version in the amendment dated September 15, 2006. Thus the changes in the abstract do not need to be "picked-up" from a number of different prior amendments.

In addition, the changes in the specification also do not appear to be excessive especially because of the requirement in rule 121 that all changes in a changed paragraph must be made in relation to the immediately prior version of that paragraph.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Striker", with a long, sweeping horizontal line extending to the right.

Michael J. Striker,  
Attorney for the Applicants

Reg. No. 27,233